

REMARKS

I. Introduction

In response to the Office Action dated April 7, 2004, claims 35, 47, and 57 have been amended. Claims 35-68 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicant's attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. Drawing Objections and 35 USC §112 Rejections

In paragraph (2) of the Office Action, the drawings were objected to for failing to show every feature of the invention specified in the claims. Specifically, claims 39 and 61, 42, 52, and 64, 43, 53, and 65, 44, 54, and 66, 45, 55, and 67, and claim 48 were all objected to for a lack of support in the drawings.

Applicant traverses these rejections. Support is found in the drawings for the claimed limitations.

Specifically, FIG. 1 illustrates a box labeled 114. The representation of the box incorporates and represents many things that can perform significant functionality. For example, with respect to claims 39 and 61, page 5, lines 2-5 provide for storing audio/visual information in encrypted form in the hand held computing device. Further, page 7, lines 11-12 (and significant other portions of the specification) clearly indicate that box 114 of FIG. 1 is a handheld computing device or PDA. Accordingly, the limitations of claims 39 and 61 are supported by the drawings.

Claims 42, 52, and 64 provide that the hand held computing device is configured to control a VCR that is incorporated into one or more STBs. The specification, page 10, line 23 – page 11, line 11 clearly describe a set top box that is an integral portion of a VCR and/or that has been incorporated into a VCR. In addition, page 7, lines 11-12 describes the hand held computing device 114 controlling the set top box 110. FIG. 1 and 2 illustrate the STB 110, hand held computing

device 114, and transmission signals 111. Accordingly, these claims are clearly supported by the drawings.

Claims 43, 53, and 65 provide that the handheld computing device and one or more STBs are configured to filter out desirable information from the broadcast audio/visual information for transmission and storage on the hand held computing device. In addition to objecting to the drawings with respect to these claims, the Office Action also rejected the claims under 35 USC 112 stating that the specification only discloses the STB is configured to filter out desirable information at page 9, lines 10-14 and that the specification fails to describe the hand held computing device filtering out the information. Applicant respectfully traverses the drawing objection and 112 rejection. The Office Action admits support for the STB functionality set forth in the claims. In addition, page 12, lines 23-24 provide "Consequently, out of all of the information broadcast, the desirable information can be filtered out and captured by the PDA 114". Thus, the specification clearly provides support for the claim language. In addition, FIG. 1, which illustrates both a PDA 114 and an STB 110, clearly provides support for the functionality that is claimed.

Claims 44, 54, and 66 provide that the audio/visual information is transmitted from one of the STBs to the hand held computing device over a constant periodic interval. Page 9, lines 23-24 provide that the signal transmitted to the PDA 114 by the STB 110 over a constant periodic interval. Again, FIG. 1 clearly illustrates both a PDA 114, an STB 110 and a transmission between the PDA 114 and STB 110 via communication links 122 and 124. Such depictions in the drawing represents the functionality described in the specification thereby providing sufficient support under 37 CFR 1.83(a).

Claims 45, 55, and 67 provide that the audio/visual information is transmitted from the STB to the handheld computing device only when an amount of the audio/visual information exceeds a threshold. Page 9, lines 26-29 provides: "...the signal may be transmitted by the set top box 110 only when the amount of information to be transferred to the PDA exceeds a preset or selectable threshold". This description clearly refers to set top box 110 that is illustrated in FIG. 1 along with handheld computing device 114. Thus, the STB 110 and PDA 114 of FIG. 1 provide support for and include the functionality and limitations described in the specification.

Claim 48 provides that the first and second hand held computing devices are different devices. With respect to the graphical drawing symbol or labeled representation, multiple figures

provide such support. Figure 1 illustrates a PDA 114 and set top box 110. The set top box 110 is a set top box that is compatible with multiple handheld devices/PDAs as recited in specification (see below). Accordingly, multiple different set top boxes may be used interchangeably as set top box 110. Further, PDA 114 is also a hand held computing device that may interact with any compatible set top box. Accordingly, PDA 114 can represent multiple different hand held computing devices that can interact with a compatible set top box 110. Thus, the labeled representations 114 and 110 are general boxes (where a detailed illustration is not necessary) that clearly provide support for the claimed invention.

Figure 2 also illustrates such compatible hand held computing devices 114 and compatible set top boxes 110 that communicate with each other. Figure 4 further provides specific support for practicing the method of the invention. Step 408 provides for transmitting information to a box. The text on page 14 of the specification lines 24 through 30 provides that a "transmission may be to a set top box 110 that is different from the original set top box the received transmission from the satellite, or it may be the same set top box." Thus, multiple set top boxes communicating and interacting with a handheld computing device is provided for in step 408 of Figure 4. Step 408 also supports the scenario for multiple handheld computing devices interacting with a set top box. Such a scenario is supported by text on page 13 of the specification lines 14-17 and 23-27 that provide that the PDA may communicate with any compatible set top box.

The notion that a handheld device may communicate with any compatible set top box indicates that a set top box may interact with multiple different PDA's as long as that set top box is compatible with those other handheld devices. Page 12, lines 8-12 also provide that any user can modify "a music CD in any hotel room or other location while on vacation as long as that facility has a compatible set top box 110." Thus, throughout the text of the specification (that is supported in the drawings), the application discusses in numerous manners, the use of different handheld devices with compatible set top boxes. The specification provides that any user may use his or her handheld device (e.g. to modify a music CD) with a compatible set top box while on vacation. Such a concept clearly indicates that different PDAs/handheld devices may be used with a set top box and hotel room. Otherwise, the set top box in a hotel room would be useless, since it could only communicate with a single user and not with a guest using his/her PDA on vacation there (as described in the specification).

In view of the above, Applicant submits that both the drawings and specification provide support for the claimed invention. Accordingly, Applicant respectfully requests that the rejections/objections be withdrawn.

IV. Prior Art Rejections

A. The Office Action Rejections

In paragraphs (5)-(6) of the Office Action, claims 35-68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perlman, U.S. Patent No. 6,169,879 (Perlman) in view of the PocketTV™ article (PocketTV™), and further in view of Huang et al., U.S. Patent No. 6,437,836 (Huang). In paragraph (7) of the Office Action, claims 35-68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schindler et al., U.S. Patent No. 5,675,390 (Schindler) in view of PocketTV™, and further in view of Huang.

Specifically, independent claim 35 was rejected as follows:

In consideration of claim 35, the Perlman et al. reference discloses a method, system, and article of manufacture for facilitating communications between a WebTV "set top box" [40] and a plurality of "electronic devices" defined as "any number of type of various consumer electronic devices that provide audio output, video output, or information services" (Col 6, Lines 45-60). The system implicitly comprises "two or more set top boxes (STBs)" [40] or WebTV boxes (Col 8, Lines 12-15) associated with a given user's home entertainment system for "controlling a display of audio/visual information" [110]. A WebTV, as defined in the Microsoft Computer Dictionary 5th Edition, is a "system that provides consumers with the ability to access the Web as well as send and receive e-mail on a television by means of a set-top box equipped with a modem".

The reference discloses that the "set top box" [40] is operable to "receive broadcast audio/visual information" (Col 7, Line 66 - Col 8, Line 4) and "receive" / "transmit audio/video information" from/to any of the connected sources such as a VCR [130] whereupon it is "transformed . . . to a form suitable for presentation on an output device" for "display on the output device" [110] (Col 9, Lines 23-30, 46-65). The reference, however, does not explicitly disclose nor preclude that the aforementioned interconnected "electronic devices" would not further include a "handheld computer device" such as one that provides audio output, video output, or information services. The "PocketTV Brings Video to Palm-size PC" article discloses a "handheld computing device" such as a PDA (ex. HP Jornada 430sc) that further provides audio and video output in a manner such that it "becomes a miniature VCR" and further inherently supports the ability to "transmit" and "receive" video files to a computer, as further evidenced by the "HP Jornada 430/430sc Palm-size PC User's Guide" of record. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a "handheld computing device" as disclosed in the PocketTV™ article in conjunction with the "set top box" [40] interconnection teachings of Perlman for the purposes of enabling the recording/storage of "audio/visual information" on a portable device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

Taken in combination, the combined teachings disclose a "set top box" [40] that facilitates the distribution of audio/visual information to, from, and between a plurality of interconnected electronic devices including "handheld computing device" for display on the "output device"

[110]. However, the reference does not explicitly disclose nor preclude that the "handheld computing device" is further configured to facilitate remote control type functions. The Huang et al. reference discloses the particular usage of a "handheld computing device" or PDA that is operable to "receive a user command from a user" and "translate the user command into a command signal" so as to "control one or more of the STBs using the command signal" (Col 6, Lines 16-31; Col 7, Lines 43-58). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the "handheld computing device" of the combined teachings for the purpose of utilizing a PDA as a platform for a remote control that advantageously facilitates added flexibility and functionality (Huang et al.: Col 3, Line 51 - Col 4, Line 21).

Applicant traverses the above rejections for one or more of the following reasons:

- (1) Neither Perlman, PockerTV™, Huang, or Schindler teach, disclose or suggest a handheld computing device transmitting audio/visual information to a set top box; and
- (2) Neither Perlman, PockerTV™, Huang, or Schindler teach, disclose or suggest a set top box displaying audio/visual information (on a display device) where the audio/visual information has been received from a handheld computing device.

Independent claims 35, 47, and 57 provide for displaying audio/visual information on an output device by using a set top box and hand held computing device. Specifically, the handheld computing device is used to control the set top box (similar to a remote control) and store audio/visual information. The new claims provide the ability for the handheld computing device to receive and store audio/visual information from the set top box and then transmit the audio/visual information to the same (or different) set top box for display of the transmitted information on the output device. None of the prior art references, either alone or in combination, implicitly or explicitly, provide the ability for such a system or hand held computing device that performs such combined functionality as claimed.

B. The Independent Claims Are Patentable Over Perlman in View of PockerTV and further in View of Huang

The rejection relies on Perlman to teach a WebTV set top box environment. Applicant agrees that Perlman discloses a WebTV box. Perlman also describes a central electronics device 40 (not an STB) that receives cable television signals from a cable provider (see col. 7, lines 66-col. 8, line 4). Perlman further describes that all video, audio, or data signals must pass through central electronics device 40 when it is transmitted between cable box 122, VCR 130, television set 110,

consumer electronics devices 106 and 108, and cable jack 124. As admitted in the Office Action, Perlman completely fails to describe the following claimed limitations:

- (1) transmitting audio/visual information to a handheld computing device;
- (2) receiving audio/visual information from a handheld computing device;
- (3) transforming the audio/visual information received from the handheld computing device to a form suitable for presentation on an output device; and
- (4) causing the transformed information (that was received from the handheld computing device) to be displayed on an output device.

To teach these elements, the Office Action again relies on the PocketTV article. However, Applicant submits that the Office Action completely misinterprets the language of the PocketTV article and construes it in an improper manner. As previously stated, the PocketTV article completely fails to teach the transmission of audio/visual information to a set top box for display on an output device. Instead, the PocketTV article is limited in that it merely describes the playback of an MPEG clip on the handheld device itself. In this regard, there is no description whatsoever for receiving the MPEG clip or transmitting the MPEG clip. Nor is there any description of receiving the MPEG clip or transmitting of an MPEG clip to a set top box (as claimed).

The PocketTV article does state that the device may be an HP Jornada 430se device. In this regard, the Office Action relies on the HP Jornada User's Guide to teach the transmission and reception of video files from/to a computer. However, the User Guide describes the ability to "send and receive files by infrared beam between P/PCs, between the P/PC and a handheld PC (H/PC), or between the P/PC and a desktop PC." (see page 8, item 3). In other words, the HP Jornada device is configured to receive files from and transmit files to a personal computer (PC). Such files could include the MPEG files described in the PocketTV article.

In view of the above, there is obviously a clear problem with the combination of the HP Jornada User Guide and the PocketTV article with respect to the present invention—they fail to teach any communication whatsoever with a STB as set forth in the claims. In fact, Applicant submits that there would be no reason at all for the PocketTV device to be used with an STB. Nor could the PocketTV device be used with an STB. In this regard, the PocketTV device requires MPEG files that are encoded by a PC. Such limitations do not exist in the present claims. In addition, the sole purpose of the PocketTV device is that it provides an "MPEG movie viewer for

Windows-CE Palm size and Handheld PCs" (see first paragraph of PocketTV article). Thus, the PocketTV's stated purpose is to view movies on a handheld device. It is not intended to transmit files to an STB for viewing on a display device or a television. Nor does PocketTV describe the transmission of an MPEG file to a computer or STB for viewing on another device. In fact, there would be no reason for a PocketTV user to do transmit files back to a computer – instead, PocketTV is limited by its own description to viewing movies on the device itself.

In addition to the above, Applicant submits that while the PocketTV article can be combined with the HP Jornada User Guide, there is no suggestion, motivation, or rationale for using either the PocketTV article or HP Jornada User Guide with the Perlman device. In fact, the Office Action admits that Perlman fails to describe a handheld computing device as part of its description (see bottom of page 5 and top of page 6 of Office Action). Further, Perlman's description solely refers to and is limited to consumer electronic devices that are included in a home entertainment or information retrieval system (see col. 6, lines 43-45). Perlman specifically lists large standard entertainment unit systems such as cable boxes, satellite receivers, video cassette recorders, video game consoles, video disk players, home theater equipment, home stereo equipment, etc. (see col. 6, lines 45-54). However, notoriously absent from any the entire description of Perlman is a handheld device as claimed. Further, notoriously absent from both the PocketTV article and the User Guide is any reference whatsoever to a connection with anything other than a computer.

Despite the lack of any motivation to combine, the Office Action merely transitions to the description of the PocketTV article after describing the Perlman reference and then concludes that it would be obvious to combine the references. Applicant respectfully disagrees with such an obviousness determination. There is no suggestion or indication, implicit or explicit, in either Perlman, PocketTV, or HP User Guide that the references should be combined with each other. The Office Action rationale provides that the combination would be for the purpose of enabling the recording/storage of audio/visual information on a portable device that may advantageously allow for the storage of an entire movie in your pocket. However, even without Perlman, the PocketTV article meets this "advantage". Accordingly, the combination is not even remotely suggested. In fact, Applicant submits that since the sole point of PocketTV is to provide an MPEG viewer in a handheld device, PocketTV teaches away from transmitting such material to any Perlman device.

Further, Perlman does not even remotely suggest the use of a handheld device or portable device whatsoever that may be linked with its system.

The Response to Argument section of the Office Action asserts that the HP Jornada PDA "supports the transfer of video files both to and from the device". Applicant respectfully disagrees. There is no description of the transfer of any video files both to and from a "device". Instead, as described above, it is limited to transmission from a PC and not a "set top box" as claimed. There are significant differences that are well established between an STB and a standard PC. Set top boxes are a term of art with specific functionality that are clearly distinguishable from a standard PC that is described in the HP User Guide. In this regard, contrary to that asserted in the Office Action, the HP Jornada does not meet the definition as set forth in Perlman of an "electronic device".

The Response to Arguments section further asserts that the features upon which Applicant relies are not recited in the rejected claims. Applicant respectfully disagrees. Firstly, Applicant does not rely upon streaming video in the earlier arguments. The PocketTV article itself describes streaming video and indicates that it is not yet available. Applicant was merely pointing out that the ability to receive and view live video on the PDA device was not implemented. Accordingly, any reference to that portion of the article would be improper since it could not teach the invention as claimed.

The Office Action continues and relies on the teaching of Huang for controlling one or more STBs using the command signal. While Huang discloses a remote control system via a PDA (see col. 4, lines 62-66 and Title), Huang still fails to cure the deficiencies of Perlman, PocketTV, and the HP User Guide as described above. Specifically, Huang is limited to the user of a PDA as a remote control to control consumer electronics devices (see col. 4, line 66-col. 5, line 1). However, Huang still fails to teach the receiving or transmitting of audio/visual information from a handheld device to an STB as claimed. Further, none of the cited references even remotely describe an STB that is capable of displaying audio/visual information on a display where that audio/visual information was received from a handheld computing device (as claimed).

Independent claim 47 provides similar limitations to that described with respect to claim 35. Dependent claim 48 further provides that a first and second handheld devices are different devices. These claims were rejected as follows:

Claims 47 and 48 are rejected as previous set forth in the rejection of claim 35. The aforementioned combined references do not explicitly disclose the particularly claimed scenario wherein a "first of one or more hand held computing devices" is operable to interact with a STB (Claim 47) such that "the first hand held computing device and second hand held computing device are different handheld computing devices". In response to the examiner's previous objection pertaining to the drawings failing to illustrate such a scenario utilizing multiple "handheld computing devices" in conjunction with a single "set top box", the applicant admits that such a scenario is a "conventional feature" and as such need not be shown in the Figures (Paper 10, Page 7). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention that the aforementioned combined teachings of Perlman would be operable to utilize both a "first" and a "second handheld computing device" that are different for the purposes of enabling a viewer to transport and share media with another user with a similar configuration.

Applicant respectfully traverses the above rejection. With respect to the drawing rejections, 37 CFR 1.83(a) provides that conventional features "disclosed in the description and claims, where their detailed illustration is not essential for proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or labeled representation (e.g., a labeled rectangular box". The dictionary (<http://dictionary.reference.com/search?q=conventional>) defines the term "conventional as follows:

con ven tion al adj.

1. Based on or in accordance with general agreement, use, or practice; customary: *conventional symbols; a conventional form of address.*
2. Conforming to established practice or accepted standards; traditional: *a conventional church wedding.*
 - a. Devoted to or bound by conventions to the point of artificiality; ceremonious.
 - b. Unimaginative; conformist: *longed to escape from their conventional, bourgeois lives.*
3. Represented, as in a work of art, in simplified or abstract form.
4. ~~Law~~ Based on consent or agreement; contractual.
5. Of, relating to, or resembling an assembly.
6. Using means other than nuclear weapons or energy: *conventional warfare; conventional power plants*

Thus, contrary to that suggested by the Examiner, the term conventional does not mean described in the prior art or admitted in the prior art. Applicant has not admitted nor suggested that the use of different handheld computing devices in the context of the claimed invention was in the prior art or admitted in the prior art. Instead, Applicant provided that the claimed scenarios (wherein different hand held computing devices are used) contained conventional features that were described in the specification and claims. The specification and claims described a scenario wherein a handheld computing device communicated with compatible STBs and wherein the STBs communicated with multiple compatible handheld computing devices. In that the drawings illustrate an STB and a hand held computing device and the specification describes multiple compatible handheld computing devices, it would be based on or in accordance with general agreement (i.e., the definition for

"conventional") that the handheld computing device illustrated is an example of the various different handheld computing devices that could be compatible with the STB. Thus, the drawings clearly provide support for the claimed invention. Further, Applicant has never stated that the claimed limitations would be obvious in view of the prior art.

Applicant further traverses the rejection of claim 57 for the reasons stated above.

The Office Action rejects claims 36, 37, 58, and 59 as follows:

In consideration of claims 36, 37, 58, and 59, it is known in the art that viewers share recorded media. The combined disclose the use of a portable "handheld computing device" in which a viewer may take recorded media along with them. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention that various scenarios for the purpose of sharing and distributing media between users with a similar configuration of home entertainment systems. For example, one of ordinary skill in the art would recognize that given multiple home entertainment systems that a user might record information on their "handheld computer device" for storage and playback on the "same" STB for the purpose of presenting such information using a larger display screen than that associated with the PDA. Similarly, in conjunction with the sharing of media, a user of a "handheld computer device" may subsequently share or distribute the media to a "different" STB associated with a friend for the purposes of sharing and viewing the recorded media on a larger display screen associated with a different location.

Applicant respectfully traverses such rejections. For the reasons stated above, the combination of the cited references fails to disclose the use of a portable "handheld computing device" in which a viewer may take recorded media along with them". Applicant also appreciates the Examiner's recognition of the benefits of the present invention of the ability to share and distribute media between users with a similar configuration of home entertainment systems. However, such advantages are only possible pursuant to the present invention. To use these advantages which are not even remotely contemplated or described in the cited art as a rationale for obviousness is improper. Such a reliance on the advantages uses impermissible hindsight. In this regard, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The rejection relies on applicant's disclosure and the benefits of Applicant's invention as a rationale for combining the references and to illustrate a reasonable expectation of success.

C. The Independent Claims Are Patentable Over Schindler in View of PocketTV and further in View of Huang

Claim 35 was rejected as follows:

In consideration of claim 35, the Schindler et al. reference discloses a method, system, and article of manufacture for facilitating communications between a computer / "set top box" [118] and a plurality of "electronic devices" (Figure 1). In light of the applicant's specification, a "set top box" is disclosed as any device capable of receiving program information signals (IA: Page 10, Lines 23-25). The reference discloses that the "set top box" [118] is operable to "receive broadcast audio/visual information" including MPEG-1 encoded signals and to "receive" / "transmit audio/video information" from/to a connected sources such as a VCR [172] whereupon it is "transformed . . . to a form suitable for presentation on an output device" for "display on the output device" [122] (Col 7, Line 44 — Col 8, Line 65). The reference, however, does not explicitly disclose the particular usage of a "handheld computing device" to be used in conjunction with the embodiment for the receiving and transmitting material to/from a computer. The PocketTV™ article, as interpreted by the applicant (Paper 18, Page 9, Lines 7-10), discloses a device or PDA that is limited to receiving and transmitting material to/from a computer. As referenced in the article, such information comprises MPEG-1 encoded video. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a "handheld computing device" as disclosed in the PocketTV™ article in conjunction with the computer / "set top box" [118] of Schindler et al. which facilitates the storage and processing of MPEG-1 encoded video for the purposes of enabling the recording/storage of "audio/visual information" on a portable device that may advantageously allow for the storage of an entire movie in your pocket (PocketTWM article).

Taken in combination, the combined teachings disclose a computer / "set top box" [118] and "handheld computing device" or PDA that are operable to interchange information and display "audio/visual information" on the "output device" [122]. However, the reference does not explicitly disclose nor preclude that the "handheld computing device" is further configured to facilitate remote control type functions. The Huang et al. reference discloses the particular usage of a "handheld computing device" or PDA that is operable to "receive a user command from a user" and "translate the user command into a command signal" so as to "control one or more of the STBs using the command signal" (Col 6, Lines 16-31; Col 7, Lines 43-58). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the "handheld computing device" of the combined teachings for the purpose of utilizing a PDA as a platform for a remote control that advantageously facilitates added flexibility and functionality (Huang et al.: Col 3, Line 51—Col 4, Line 21).

Applicant respectfully traverses these rejections. Like Perlman, Schindler merely describes a home entertainment system. Further, like Perlman, Schindler completely fails to describe the communication between a handheld computing device and a set top box as claimed. In fact, the Office Action admits such a lack of teaching "The reference, however, does not explicitly disclose the particular usage of a 'handheld computing device' to be used in conjunction with the embodiment for the receiving and transmitting material to/from a computer." Applicant previously stated that the PocketTV article and HP Jornada reference were limited to the transmission of information to and from a computer. However, as described above, the PocketTV article and HP

Jomada reference completely fail to teach, disclose, or suggest, implicitly or explicitly, the transmission of audio/visual information from the handheld computing device to an STB for display on a display device controlled by the STB. Instead, the PocketTV article is exclusively used to display video on the PocketTV device. In other words, the PocketTV article describes a "TV" that is "Pocket" size. There is no reason nor rationale for the PocketTV device to send information to an STB for display on another output device. Such a rationale/reasoning only arises via the description of the present invention.

In view of the above, while HP Jornada provides for transmitting files to a computer, the transmission of audio/visual files for display on an output device controlled by an STB is not even remotely contemplated or described by HP Jornada. Further, consistent with such an analysis, there would be no reason or rationale to use the HP Jornada device to transmit or receive audio/visual files with Schindler's system. In this regard, there is no motivation to combine Schlinder with either HP Jornada or PocketTV. The only motivation provided in the Office Action again recites the same advantage as indicated above - allowing the storage of an entire movie in your pocket. Again, such an advantage exists regardless of whether PocketTV is combined with another reference or not. Further, the advantage of carrying an entire movie in your pocket does not even remotely suggest the motivation for transmitting that movie to an STB for display on an output device. The advantage for storing an entire movie in your pocket as reflected in the PocketTV article is so that you can easily carry and then view the movie on the PocketTV device. Again, there is no description, implicit or explicit, for transmitting that movie to an STB for display on an output device.

In addition to the above, Applicant submits that the invention must be viewed as a whole. MPEP 2141.01 provides: In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The Office Action is failing to look at the invention as a whole and is instead improperly breaking up the various claim limitations and attempting to apply art to individual aspects without regard to the links between the claim elements and the "whole" invention. In this regard, the invention as a whole provides for the use of a handheld computing device to

transmit audio/visual information to a STB which then displays the received information on an output device. Such a sequence and combination of events is not contemplated, suggested, described, or alluded to by the cited references.

With respect to claims 47 and 48, Applicant reasserts the arguments from above.

V. Conclusion

In addition to the statements above, the various elements of Applicant's claimed invention together provide operational advantages over Perlman, PocketTV™, Huang, and Schindler. In addition, Applicant's invention solves problems not recognized by Perlman, PocketTV™, Huang, and Schindler.

Thus, Applicant submits that independent claims 35, 47, and 57 are allowable over Perlman, PocketTV™, Huang, and Schindler. Further, dependent claims 36-46, 48-56, and 58-68 are submitted to be allowable over Perlman, PocketTV™, Huang, and Schindler in the same manner, because they are dependent on independent claims 35, 47, and 57, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 36-46, 48-56, and 58-68 recite additional novel elements not shown by Perlman, PocketTV™, Huang, and Schindler.

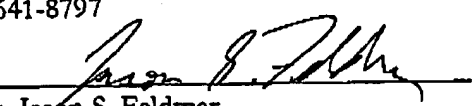
In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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